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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,571	07/16/2003	E. Michael Ackley JR.	02280.002470.1	7101

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EXAMINER	
YAN, REN LUO	

ART UNIT	PAPER NUMBER
2854	

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/619,571	ACKLEY ET AL.	
	Examiner	Art Unit	
	Ren L. Yan	2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *33-36,38-46,59 and 60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *33-36 and 38-46* is/are allowed.

6)☒ Claim(s) *59 and 60* is/are rejected.

7)☒ Claim(s) *60* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *6-5-2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim 60 is objected to because the recitation of "the composite image" on line 12 lacks proper antecedent basis. Perhaps this recitation should be changed to "said registered image" so as to maintain consistent claim terminology. Appropriate correction is required.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 59 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 106 of copending Application No. 10/695,834. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same invention with claim 59 of the present application being broader in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 60 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 106 of copending Application No. 10/695,834 in view of WO 91/01884. To provide the first and second printing means in claim 106 of copending application No. 10/695,834 with well known offset type printers as taught by WO 91/01884 would have been obvious to those having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 91/01884 in view of Ream et al((6,267,997).

WO 91/01884 teaches an apparatus for forming a registered image on a non-planar printing surface of a shaped edible piece 10 as claimed including a transport surface 22 with at least one shaped recess 23 having a non-planar surface corresponding to the shaped edible piece and a vacuum hole 29 positioned within and at the deepest portion of the shaped recess for holding the edible piece 10 laterally, longitudinally and rotationally within the shaped recess at a predetermined position, a first offset printer station 35 at a first position along a transport path that forms a first component image in ink on the shaped piece while in the predetermined position, a second printer station 41(laser marking system 41) downstream from the first printer station that forms a second component of a registered image on the edible piece 10 in registration with the first component image of the registered image, and a vacuum pump to supply vacuum to

the vacuum hole 29 to maintain the edible piece in the predetermined position within the recess while the edible piece is at and between the first and second print stations such that multiple printing operations can be performed in proper registration on the edible piece. Additionally, the broad means for applying a pressure differential to the vacuum hole to maintain the edible piece in the predetermined position within the recess while the edible piece is at and between the first and second printer stations as recited in claim 59 and the vacuum pump and means for allocating pressure differential applied to the edible piece at and between the first and second printer stations as recited in claim 60 read on the vacuum pump and the vacuum chambers 27 and 28 as taught in WO 91/01884. See Figs. 1-3 and pages 8 and 9 of WO 91/01884 for details. However, the second printer station of WO 91/01884 does not apply the second component image of a registered image in ink as recited. The patent to Ream et al teach the conventionality of printing on edible pieces a registered image formed with first and second components of colored ink in proper registration by first and second printers 32. See Figs. 10, 11, column 5, lines 12-15 and column 8, lines 46-59 in Ream et al for example. It would have been obvious to one of ordinary skill in the art to provide the printing apparatus of WO 91/01884 with a second offset ink printing device appropriately disposed as taught by Ream et al in order to form a multicolor ink registered image on the tablet piece.

Claims 33-36 and 38-46 are allowed.

Applicant's arguments with respect to claims 59 and 60 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
September 20, 2006